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KILPATRICK STOCKTON LLP 607 14TH STREET, N.W. WASHINGTON, DC 20005			BORISSOV, IGOR N	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/028,718
Filing Date: December 28, 2001
Appellant(s): MARKARIAN ET AL.

MAILED

JUL 05 2006

GROUP 3600

Dawn-Marie Bey
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/10/2006 appealing from the Office action mailed 12/22/2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 6,678,518	Eerola	Jan. 13, 2004
US 2001/0056401	Tomkins	Dec. 27, 2001
US 6,078,820	Wells et al.	Jun. 20, 2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Objections

Claims 14-17 are objected to because of the following informalities:

claim 14 includes a following phrase: "The mobile commerce *system* according to claim 12", which appears to be a typographical error, because claim 12 is a *method* claim. Same reasoning applied to claims 15-17.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eerola (US 6,678,518) in view of Tomkins (US 2001/0056401).

Eerola teaches a method and system for dynamically converting data between a mobile station in a wireless communication network and an origin server in a wide area network, comprising:

Claims 1, 12 and 18,

sending from a mobile station a Wireless Markup Language (WML) encoded URL request for a resource (C. 4, L. 14., C. 5, L. 15-17);

receiving said request at a gateway server and re-formatting said request into HTML format (C. 4, L. 15., C. 5, L. 18-26);

communicating said re-formatted request to a particular resource information on the World Wide Web, and receiving the requested resource information at said gateway (C. 5, L. 18-26);

parsing said received resource information and re-formatting the processed information into WML encoded message to transmit it back to said mobile station (C. 5, L. 36-50).

Eerola does not specifically teach: sending a purchase request to a merchant website; sending a purchase request response, including a payment authorization request, from the merchant website to a payment authorization system; and transmitting said purchase request response to the mobile device.

Tomkins teaches a method and system for providing financial services over the Internet, including:

sending a purchase request from a customer mobile terminal (cell phone) to a merchant website; transmitting a payment authorization request from the merchant website to a bank server which authorizes or denies the transaction; notifying the customer that the transaction has been approved or denied [0065]; [0028]; wherein the protocol conversion aspect converts content developed in HTML into Wireless Markup Language (WML) [0032].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Eerola to include said cell phone purchase request and authorization functionality, as disclosed in Tomkins, because it would advantageously allow customers to conduct shopping over the Internet at any suitable location and at any time convenient for the customer.

Furthermore, Eerola teaches:

Claims 2 and 14, said method and system, wherein said first language is wireless language (C. 4, L. 14; C. 5, L. 15-17).

Claims 3 and 15, said method and system, wherein said first language is Wireless Markup Language (WML) (C. 4, L. 14; C. 5, L. 15-17).

Claims 4 and 16, said method and system, wherein said second language is web-based language (C. 4, L. 15; C. 5, L. 18-26);

Claims 5 and 17, said method and system, wherein said second language is HTML language (C. 4, L. 15; C. 5, L. 18-26);

Claim 6. Said system, including a parsing engine, a communication module, a translating/formatting module, and an administrator module (C. 4, L. 13-34).

Claim 7. Tomkins teaches said system, including a customer account database [0031]. The motivation to combine Eerola and Tomkins would be to advantageously allow customers to conduct shopping over the Internet at any suitable location and at any convenient for the customer time.

Claim 8. Tomkins teaches said system, including a notification system for notifying a customer through the mobile device, and a payment authorization system for responding to the authorization request [0065]; [0028]. The motivation to combine Eerola and Tomkins would be to advantageously allow customers to conduct shopping over the Internet at any suitable location and at any convenient for the customer time.

Claim 9. Tomkins teaches said system, wherein the notification system communicates with the mobile device in a third (Compact HTML) language [0032]. The motivation to combine Eerola and Tomkins would be to advantageously allow customers to conduct shopping over the Internet at any suitable location and at any convenient for the customer time.

Claim 11. Tomkins teaches said system, comprising a customer information repository including a customer shipping address, a list of payment vehicles and a customer ID (0070). The motivation to combine Eerola and Tomkins would be to advantageously allow customers to conduct shopping over the Internet at any suitable location and at any convenient for the customer time.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eerola in view of Tomkins and further in view of Wells et al. (US 6,078,820) (Wells).

Claim 10. Eerola in view of Tomkins teach all the limitations of claim 10, except that said third language is short message services (SMS).

Wells teaches a system for real-time SMS application messaging, which includes a SMS-linked server (C. 3, L. 8-9).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Eerola and Tomkins to include a SMS functionality, as disclosed in Wells, because it would advantageously allow SMS system users to conduct e-commerce in any convenient location and any suitable time without incurring high cost for wireless connection.

(10) Response to Argument

Applicant argues (Brief; page 7, 4th paragraph) that Tompkin (US 2001/0056401) is not a prior art under 35 U.S.C. 103(c), because both US 2001/0056401 (Tomkins) and present patent application are assigned to Citicorp Development Center, Inc. (hereinafter "CDC").

In response to this argument, Examiner points out that US 2001/0056401 (Tomkins) application was assigned to CDC on July 26, 2001. The present patent application was assigned to CDC on April 08, 2002, and has an effective date December 28, 2001. Therefore, contrary to the Applicant's statement, at the time the present invention was made US 2001/0056401 (Tomkin) application and present patent application *were not commonly owned* by CDC, and Tompkin (US 2001/0056401) is a prior art under 35 U.S.C. 103(c),

Applicant argues (Brief; page 9, 2nd paragraph) that cited Tompkins' paragraphs [0028] and [0065] are unrelated.

In response to this argument, it is noted that Tomkins was applied for processing of purchase request and authorization functionality. While Tompkins' paragraphs [0028] and [0065] disclose two embodiments, these two embodiments each disclose: sending a purchase request from a customer terminal to a merchant website; transmitting a payment authorization request from the merchant website to a bank server which

authorizes or denies the transaction; notifying the customer that the transaction has been approved or denied.

Applicant argues (Brief; page 9, 2nd paragraph) that neither of the paragraphs cited in Tompkins teach or suggest the combination of limitations from claims 12 or 18.

In response to this argument, Examiner points out that applicant argues against the references individually; but one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Tomkins was applied for processing of purchase request and authorization functionality. Specifically, Tomkins discloses: sending a purchase request from a customer mobile terminal (cell phone) to a merchant website; transmitting a payment authorization request from the merchant website to a bank server which authorizes or denies the transaction; notifying the customer that the transaction has been approved or denied wherein the protocol conversion aspect converts content developed in HTML into Wireless Markup Language (WML) [0065]; [0028]; [0032]. As per reformatting request for a content from a first platform format to another platform format, Eerola discloses this feature. Specifically, Eerola discloses: receiving at a gateway server a request for a content from a mobile device; re-formatting said request into HTML format; communicating said re-formatted request to a particular resource of information; receiving the requested resource information at said gateway; parsing said received resource information and re-formatting the processed information into WML encoded message to transmit it back to said mobile device (See Cl. 1).

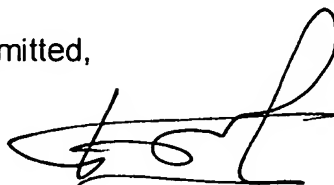
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Igor N. Borissov

A handwritten signature in black ink, appearing to be 'Igor N. Borissov', written in a cursive style.

Conferees:

John W. Hayes

A handwritten signature in black ink, appearing to be 'John W. Hayes', written in a cursive style.

Sam Sough

A handwritten signature in black ink, appearing to be 'Sam Sough', written in a cursive style.